IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.	:	6,308,317
Application No.	:	08/957,512
Re-examination No.	:	90/008,178
Confirmation No.	:	2195
Applicant	:	Wilkinson, Timothy J., et al.
Issue Date	:	Oct. 23, 2001
Docket No.	:	40.0010
Customer No.	:	41754

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition under 37 C.F.R. 1.181 for Reversal of Denial of Request of Correction of an Applicant Mistake

Dear Sir:

Applicants hereby petition under 37 C.F.R. 1.181 for reversal of the denial of the Petition for Correction of an Applicant Mistake. U.S. Patent No. 6,308,317 (the '317 patent) issued October 23, 2001. It was subsequently reexamined (90/008,178), and a Reexamination Certificate was issued on December 2, 2008 (the "Reexamination"). During the reexamination process Applicants modified several claims in an amendment filed on February 21,

2008 (the "Amendment") and in so doing introduced an error into several
independent claims. Applicants petitioned on July 30, 2010 to have these
errors corrected through issuance of a certificate of correction (the "Request
for Certificate of Correction"). That request was denied (Letter from Eva
James, Decisions & Certificate of Corrections Branch, September 8, 2010).
Applicants hereby petition for reconsideration and reversal of that decision
and entry of the Certificate of Correction filed with the Request for
Certificate of Correction.

Facts

The '317 patent relates, among other things, to the use of a high level
programming language, such as Java, in a resource-constrained environment.
Relevant to the present petition and the certificate of correction request
subject hereto, the '317 patent describes a converter that converts programs
that are the output of one programming environment into programs derived
therefrom and that may be interpreted by an interpreter other than the
interpreter intended by the programming environment. The target
interpreter may use a different instruction set from the instruction set used
in the output of the programming environment. One operation of the
conversion process is the renumbering of byte codes used to define
instructions from the instruction set used by the programming environment
into corresponding byte codes in the instruction set used by the target
interpreter.

The specification discloses and claims the invention in the context of
devices that are the target of a conversion process, including, for example, for
an "integrated circuit card" and a "microcontroller." Nearly verbatim claim
limitations are recited in the claims with some claims reciting an "integrated
circuit card" in the preamble to the invention and others reciting a
"microcontroller" instead (*compare, e.g.*, claims 1 and 58). During

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reexamination, Applicant modified claim 1, directed to an integrated circuit card, by amending the limitation that defines the target instruction set of the renumbering operation of the conversion process from "renumbering byte codes in a compiled format to equivalent byte codes in a format suitable for interpretation" to recite "renumbering byte codes in the compiled form to equivalent byte codes in an instruction set supported by an interpreter on the *integrated circuit card*." 90/008,178, **REPLY AND AMENDMENT UNDER 37 CFR 1.111 and 37 CFR 1.530**, filed February 21, 2008. Applicants made this amendment a global amendment to all occurrences of the same limitation in the claims, and, by doing so, accidentally neglected the fact that there are some claims to the invention that recite a "microcontroller" as the target device. Because these claims recite a "microcontroller," not an "integrated circuit card," the amendment ("in an instruction set supported by an interpreter on the *integrated circuit card*") erroneously refers back to "the integrated circuit card" when it is clear (because the device recited in the preamble is a microcontroller) it should refer back to a "*microcontroller*." Applicant thus petitions to replace "integrated circuit card" in claims 58, 65, 78, 87, 88, and 92 (all of which recite a microcontroller in the preamble) with "microcontroller" to correct this error.

Points to Be Reviewed

Whether the denial of the requested Certificate of Correction was proper.

Action Requested

Applicants petition for the reversal of the refusal to issue a requested Certificate of Correction.

<div align="center">**Authority**</div>

Statute

Under certain circumstances, an Applicant mistake during prosecution of a patent may be corrected by Certificate of Correction. 35 U.S.C. § 255; *see also* 37 CFR 1.323 and MPEP 1481. Specifically, if the following conditions are satisfied, a Certificate of Correction may be used to correct an Applicant mistake:

> (A) mistake must be of a clerical or typographical nature, or of minor character, the correction of which does not involve such changes in the patent as would constitute new matter or would require reexamination;
>
> (B) which was not the fault of the Patent and Trademark Office;
>
> (C) such mistake occurred in good faith; and
>
> (D) payment of the required fee.

35 U.S.C. § 255. In the case of the '317 patent, all of these requirements are satisfied. Accordingly, this Petition for Correction of an Applicant Mistake should be granted.

MPEP

This statutory language is restated in the MPEP as involving two statutory concerns: (1) the nature of the mistake, and (2) the nature of the proposed corrections. MPEP 1481. To satisfy the requirement vis-à-vis the nature of the mistake, the mistake must be (1) of a clerical nature, (2) of a typographical nature, or (3) a mistake of minor character. The meaning of these terms was addressed by the Court of Appeals for the Federal Circuit (CAFC) in *Superior Fireplace v. Majestic Products,* 270 F.3d 1358, 1373 (Fed. Cir. 2001)).

Clerical or Typographical Nature

In *Superior Fireplace* the court observed that the phrases "clerical or typographical nature" and "of minor character" are not explicitly defined in § 255. Therefore, the court looked to the plain meaning of these phrases and relied on dictionary definitions to assess that plain meaning. From the dictionary definitions, the court arrived at the conclusion that "clerical or typographical mistakes are generally understood to include simple mistakes such as obvious misspellings that are immediately apparent. Upon viewing such a misspelling, there is no doubt that a mistake, indeed a clerical or typographical mistake, has occurred. *Superior Fireplace,* 270 F.3d 1358, 1370.

Superior Fireplace characterizes typographical errors as being in one of three categories. A first being such errors that leave no doubt as to what the mistake is, e.g., misspellings such as "frane" instead of "frame." The second category are those that lead to another word that reads logically in the context of the sentence. A third category is those mistakes where it is clear that a mistake has been made, but it is unclear what the mistake is.

While the *Superior Fireplace* court focused its discussion of clerical and typographical errors on such things as misspellings, in a case following *Superior Fireplace*, the Federal Circuit extended the application of the provisions for correcting typographical and clerical errors of § 255 to errors well-beyond mere inadvertent substitutions of characters. In *Arthrocare v. Smith & Nephew*, the Federal Circuit applied § 255 to a mistake made in changing a claim element from "active electrode" to "electrode terminal" that had been caused by an incorrectly made amendment during the prosecution of the application for patent. 406 F.3d 1365, 1374-75 (Fed. Cir. 2005) (citing *Superior Fireplace Co. v. Majestic Prods. Co.*, 270 F.3d 1358, 1373 (Fed. Cir. 2001)).

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In *Arthocare v. Smith & Nephew*, the Federal Circuit evaluated a Certificate of Correction to correct an Applicant mistake and held, "The correction of a ministerial error in the claims, which also serves to broaden the claims, is allowable if it is 'clearly evident from the specifications, drawings, and prosecution history how the error should appropriately be corrected' to one of skill in the art." 406 F.3d 1365, 1374-75 (Fed. Cir. 2005) (citing *Superior Fireplace Co. v. Majestic Prods. Co.*, 270 F.3d 1358, 1373 (Fed. Cir. 2001)). In *Arthocare*, Applicant meant to globally change all occurrences of the term "active electrode" in the claims to "electrode terminal," but accidentally left a few occurrences unchanged. *Id.* at 1374 ("Those amendments changed the term 'active electrode' to 'electrode terminal' in three places in claim 1 ... but did not make the change in a fourth place, where the term 'active electrode' was left unchanged.") Claims that erroneously contained both terms appeared to call for an additional type of electrode. *Id.* at 1375. Applicant realized his mistake after the patent issued and filed for and received a Certificate of Correction to replace the remaining occurrences of "active electrode" with the term "electrode terminal," which the PTO issued. *Id.* at 1374. The Federal Circuit held the Certificate of Correction valid.

The Federal Circuit reviewed the specification and prosecution history and found it clear that the prosecuting attorney made a "typographical error" and that it was proper to change "active electrode" to "electrode terminal" using a Certificate of Correction, even though the correction had the affect of broadening the claim. *Id.* at 1375 ("In the first place, claim 1 does not make sense if it is interpreted to contain three types of electrodes instead of two.... The prosecution history further supports ArthroCare's argument that it was unambiguous how the remaining reference to an active electrode in claim 1 should be changed.... The prosecuting attorney's failure to replace the term "active electrode' twice in

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the claims instead of once, does not demonstrate ... that a person of ordinary skill in the art would not understand how to correct those errors.") Thus, a Certificate of Correction is an appropriate means to change a clear typographical error in the claims, if it is clearly evident how to correct the error.

Of minor character

Superior Fireplace analyzed the meaning "of minor character" by turning to the plain meaning of the phrase. 270 F.3d 1358, 1375. The court noted that "'[minor]' is commonly defined as 'lesser in importance ... [or] seriousness...'" *citing*, The American Heritage College Dictionary 869 (3d ed. 1993). The *Superior Fireplace* court applied this definition in the context of patents by focusing on the claim scope and asserting that "based on the plain meaning of the statutory language, we interpret 'a mistake of ... minor character' to exclude mistakes that broaden a claim." *id.* However, as mentioned above and discussed further herein below, under certain circumstances, a certificate of correction may issue for corrections that are broadening.

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Analysis

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Summary of the Invention

The technology presented and claimed by the applicants allows for a program developed in a high-level language to be developed using off-the-shelf tools and compiled using such tools, then converted using a converter into a format suitable for interpretation on a target device that would not normally support interpretation of programs developed in the high-level language. One example is the JAVA programming language. Programs for a target device that lack resources necessary to support the JAVA virtual

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machine may nevertheless be developed for the resource-constrained target device in JAVA using standard tools. The output from the standard tools may be referred to as the *compiled code*. Applicants' converter accepts as input, for example, the output of the JAVA programming tools and creates a program in a format suitable for interpretation on the target device using an interpreter.

The error introduced in the re-examination deals with defining a target domain for one particular operation of the converter, namely the renumbering operation. That error inadvertently caused a back-reference intended to refer back to the preamble of each claim, respectively, to for one group of claims to refer back to the preamble of the other group of claims.

To aid in understanding the context of the renumbering operation and the error, Applicants provide herein below a brief summary of the disclosed technology with special focus on the renumbering operation of the converter.

The converter performs one of several manipulations on the compiled code and produces a derived application – derived from the original program developed in the high-level language and converted by the converter from the compiled code corresponding to the high-level language program.

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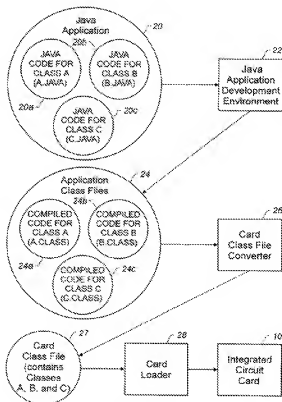Figure 2 of the '317 patent is illustrative:

FIGURE 2

In the context of Figure 2, the off-the-shelf tools are depicted as Java Application Development Environment 22. The development environment 22 produces a compiled form in the form of Application Class Files 24. These are fed into the converter 26, which produces the Card Class File 27 which may be loaded onto a target device (e.g., Card 10) and interpreted thereon by an interpreter on the target device.

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The converter performs a process to convert a program in original byte codes produced by the programming environment into modified byte codes. One possible flow of these operations is illustrated in Figure 6:
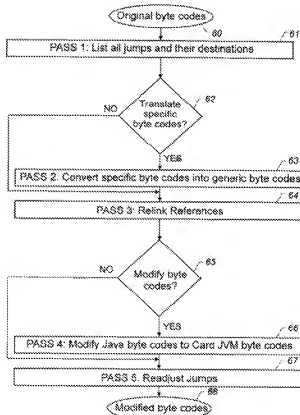

FIGURE 6

The original byte codes 60 (which may be found in the Java Class files 24 of Figure 2) (Col. 10, Lines 13 – 17) are manipulated by one or more conversion operations (illustrated in Figure 6 and described at Col. 10, Line 13 – Col. 11, Line 48) into modified byte codes 68 (Col. 11, Lines 44 – 47).

One of these manipulations may be a renumbering of byte codes from one instruction space to another. The renumbering operation is explained at Col. 11, Lines 4 – 23. The original byte codes are modified into a different set of byte codes supported by the interpreter on the target device.

The renumbering operation is illustrated in Figure 10:

	100			102
0:	ALOAD 43		0:	ALOAD 51
1:	0		1:	0
2:	ILOAD 21		2:	ILOAD 50
3:	1		3:	1
4:	IFNE 154 2:		4:	IFNE 27 2:
5:	BIPUSH 16		5:	BIPUSH 49
6:	5		6:	5

FIGURE 10

The byte codes 100 in the original byte codes 60 are renumbered into renumbered byte codes 102. For example, in the source program 100, the byte code for the ILOAD instruction is 21. In the example interpreter, the byte code for ILOAD is 50. The renumbering operation renumbers the original byte code in location 2 of the program 100 from 21 to 50 to allow the program of the renumbered byte codes 102 to correspond to the byte codes used by the interpreter on the target device. A person skilled in the art will realize that it is important to the correct interpretation of the program by the interpreter on the target device that the byte codes in the program correspond to the equivalent byte codes used by that interpreter, e.g., if the interpreter uses 50 to designate ILOAD, the program had better also use 50 to designate ILOAD, if the interpreter uses 51 to signify ALOAD, the program had better also use 51 to signify ALOAD, and so forth. If the

converter produced byte codes in another instruction set, the interpreter on the target device would fail to correctly interpret the program.

The above-described features of the patented embodiments were captured in the patent and refined in the amendment in the re-examination process in claims that may be outlined as follows:

A *device* comprising:

a *memory* storing:

a *derivative application* derived by converting a class-file format application from a compiled form into a converted form, the *conversion* comprising:

...

renumbering byte codes into [a *target instruction set*]

...

an *interpreter* configured to interpret derived applications; and

a *processor* configured to use the interpreter to interpret the derivative application.

In other words, the claims are directed to a *device* that has a *memory* and *processor*. The *memory* stores a *derived application* and an *interpreter*. The *interpreter* is executed by the *processor* to interpret the *derived application*. The *derived application* is defined as being derived by a *conversion* step that includes *renumbering* byte codes into a *target instruction set*.[1]

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[1] The method claims follow a slightly different structure. However, the basic elements – the device, the memory, the processor, the interpreter, the conversion step including a renumbering operation into a target instruction set – are similar if not identical.

A person skilled in the art would know that the *target instruction set –* which is claimed in the re-examined patent as "an instruction set supported by an interpreter on the integrated circuit card" – must correspond to the instruction set that is used by the interpreter that is stored in the memory and used by the processor.

The Error and Requested Correction

The error for which Applicants have requested a certificate of correction concerns the manner in which the claims define the target instruction set of the renumbering operation. This definition was modified in the re-examination process to clarify the manner in which the claims define the target instruction set.

For example, in claim 58, prior to the amendment, the renumbering operation was recited as "renumbering byte codes in a compiled format to equivalent byte codes in a format suitable for interpretation." In the amendment, this was amended to "renumbering byte codes in the compiled form to equivalent byte codes in an instruction set supported by an interpreter on the integrated circuit card." In other words, in the revised claim, the target instruction set of the renumbering operation was defined by the target interpreter. The way the target interpreter was defined, in turn, was by referring back to which element that interpreter executes on, e.g., the integrated circuit card.

In the amendment, the independent claims may be grouped into two classes: (1) the *Integrated Circuit Card Claims* (1, 31, 64, 84, 85, 86, 93, and 94) and (2) the *Microcontroller Claims* (58, 65, 78, 87, 88, 91, 92). In the *Integrated Circuit Card Claims* the pre-amble is directed to an integrated circuit card or a method for use with an integrated circuit card. Conversely,

the *Microcontroller Claims* are directed to a microcontroller or a method of programming a microcontroller.

In the Amendment, regardless of whether the claim was in the Integrated Circuit Card Claims or in the Microcontroller Claims, the claims defined the target instruction set as "an instruction set supported by an interpreter on *the integrated circuit card*" (emphasis added). With respect to the Microcontroller Claims, this way of defining the instruction set is a mistake for at least two reasons:

(1) there is no antecedent basis within the claims under 34 USC 112, second paragraph for *the integrated circuit card*. In the Integrated Circuit Card Claims there is antecedent basis for "the integrated circuit card" because it is in the preamble and the interpreter is stored in the memory and executed by the processor of the integrated circuit card. On the Microcontroller claims, since those claims do not include or refer to an integrated circuit card, there is no antecedent basis for "the integrated circuit card."

(2) the claim may be construed to an inoperative structure. If the Microcontroller Claims were construed such that "an instruction set supported by an interpreter on the integrated circuit card" were given a meaning in which the instruction sets of the *interpreter on the integrated circuit card* and of the *interpreter on the microcontroller* are different, the interpreter used by the processor would be unable to interpret the derived application.

The proposed correction

The proposed correction of the above-described error is to change the definition of the interpreter used to define the target instruction set of the renumbering operation in Microcontroller Claims as follows:

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. . . . renumbering byte codes in the compiled form to equivalent byte codes in an instruction set supported by an interpreter on the [integrated circuit card] microcontroller . . . .

Of Minor Character

Certificate of Correction may be used under certain conditions to correct an Applicant mistake:

mistake must be of a clerical or typographical nature, or of minor character, the correction of which does not involve such changes in the patent as would constitute new matter or would require reexamination (35 U.S.C. § 255).

As the statute sets forth the categories of "clerical or typographical" *and* "of minor character", the statute does not limit the use of Certificate of Correction to clerical and typographical mistakes but also allows correction to other mistakes, namely, those "of minor character". Thus, even if the mistake herein was considered to not be a typographical or clerical error, it may be correctable as being a mistake of minor character.

A mistake that broadens a claim may not be considered "a mistake of minor character". Superior Fireplace, 1375. The correction that the Applicants propose does not broaden the claims. As discussed herein above, the proposed correction corrects the definition of the interpreter by which the target instruction set of the renumbering operation is defined (also referred to herein below as the *reference interpreter*). "To answer the question of whether a claim has been broadened through correction requires interpreting the old and new versions of that claim, and then determining whether the new version covers territory the old one did not." *Central Admixture Pharmacy v. Advanced Cardiac,* 482 F. 3d 1347, 1353 (Fed. Cir. 2007). The only difference between the uncorrected claims and the corrected claims is

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the definition of the reference interpreter used to determine the target instruction set. In the uncorrected version of the claims, the reference interpreter for the target instruction set is not necessarily the same as the interpreter used by the processor to interpret the derived application. However, it could be.

On the other hand, in the proposed correction, because there would be an exact match between the reference interpreter used to define the target of the renumbering operation and the interpreter used by the processor to interpret the derived applications, the only possible alternative is that the reference interpreter is the same as the processor used to interpret the derivative application. In other words, the proposed correction reduces the possibilities defining the interpreter used to define the target instruction set. Thus, the correction narrows the claim.

While *Superior Fireplace* does not state that all narrowing corrections are to be considered "of minor character," Applicants posit that the present correction must be considered as such. The correction does not fundamentally change the claimed structure: there is neither a removal of an element, addition of an element, nor change of one element for another. In the elements affected by the correction, there is still a renumbering operation with a target instruction set defined in terms of an interpreter. The only difference is which reference interpreter is used to define the target instruction set. The proposed corrected definition is what a person of ordinary skill in the art would have observed as being the only possible workable alternative because any other instruction set would lead to a program that could not be correctly interpreted by the interpreter used by the processor to interpret the derived application.

Accordingly, Applicants respectfully submit that the mistake for which Applicants have requested the issuance of a certificate of correction is a

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mistake of minor character and therefore a certificate of correction may be issued.

    In the alternative, even if the correction were considered broadening, the correction is allowable.

    The Federal Circuit has established that a Certificate of Correction may be used to correct clear typographical errors, including those in the claims. In *Arthocare v. Smith & Nephew*, the Federal Circuit evaluated a Certificate of Correction to correct an Applicant mistake and held, "The correction of a ministerial error in the claims, which also serves to broaden the claims, is allowable if it is 'clearly evident from the specifications, drawings, and prosecution history how the error should appropriately be corrected' to one of skill in the art." 406 F.3d 1365, 1374-75 (Fed. Cir. 2005) (citing *Superior Fireplace Co. v. Majestic Prods. Co.*, 270 F.3d 1358, 1373 (Fed. Cir. 2001)). Applicants posit that applying that standard to the present application, the proposed correction should be allowed.

    The Specification Supports the Proposed Correction

    First, the correction of the error is evident from the specification and drawings. As discussed herein above, the renumbering operation of the conversion process that creates the derived application would only produce a program that is executable by the interpreter stored on the processor if the renumbering operation renumbers byte codes in the compiled form into an instruction set expected by the interpreter executed by the processor. Figure 1 of '317 shows the interpreter (Card Java Virtual Machine 16) on the integrated circuit card 10. Figure 2 and the supporting description illustrate that the card class file converter produces a derived application (card class file 27) that is loaded onto the integrated circuit card 10.

Thus, following the flow of Figure 2, the integrated circuit card would have the Card JVM and the derived application loaded thereon. The specification states that "the integrated circuit card 10 contains a card Java virtual machine (Card JVM) 16, which is used to interpret applications which are contained on the card." Col. 8, Lines 20 – 22. A person skilled in the art would appreciate that the conversion process would necessarily produce a derived application in the instruction set of the card Java virtual machine.

Col. 18, Line 31 – Col. 19, Line 30 of '317 contains a description of several alternatives to the integrated circuit card embodiment that is the primary example described in the specification. "Most existing devices and new designs that utilize a microcontroller could use this invention to provide the ability to program the microcontroller using a high level language, and application of this invention to such devices is specifically included." Col. 18, Lines 31 – 38. For that to work, as would be appreciated by a person skilled in the art, the process of producing the applications must use the same reference instruction set as the interpreter that interprets them. The converter performs that process. The renumbering operation provides for renumbering byte codes into the instruction set of the interpreter that will interpret the derived program, namely, in the case of the integrated circuit card, the interpreter on the integrated circuit card. In the applications to other devices besides the integrated circuit card embodiments, e.g., the automobile application illustrated in Figure 25, there may not be an integrated circuit card, and for such applications it would be more appropriate to define the target instruction reference interpreter by its location on the microcontroller.

The specification and drawings do not disclose a mechanism in which an interpreter other than the interpreter on the target device is used as the reference interpreter for defining the target instruction set of the renumbering operation.

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For the foregoing reasons, because the specification and drawings disclose and illustrate embodiments in which the target instruction set of the renumbering operation is the same as the instruction set of the interpreter on the microcontroller that will interpret derived applications, and no alternatives thereto, it would be evident from an analysis of the mistake with respect to the specification and drawings that the mistake should be corrected as set forth in the proposed certificate of correction.

It Is Evident from the Prosecution History that the Proposed Correction Is Proper

It is also evident from the prosecution history that the mistake should be corrected as proposed. Prior to the Amendment, the renumbering operation was recited as "renumbering byte codes in a compiled format to equivalent byte codes in a format suitable for interpretation." "Suitable for interpretation" implies that the derived program may be interpreted on the target interpreter, namely, the interpreter used by the processor to interpret the derived application. Otherwise, the format of the derived program would not be suitable for interpretation. A renumbering operation is a process of changing from one instruction set to another (illustrated in Figure 10 and discussed at Col. 11, Lines 4 – 23).

In the Office Action in the Reexamination, the Examiner therein cited a reference dealing with substituting one instruction for another (Lindholm, Tim and Frank Yellin, Java Virtual Machine Specification, Addison-Wesley, (1st ed., September 1996), Chapter 9: "quick instructions"), a reference dealing with re-ordering of instructions (Tanenbaum, Andrew, et al., *Using Peephole Optimization on Intermediate Code, ACM TRANSACTIONS ON PROGRAMMING LANGUAGES AND SYSTEMS. VOL. 4, NO.1 (*January 1982), at 32), and a reference dealing with operand substitutions (Gosling, U.S. Pat. No. 5,367,685, col. 4, line 59 – col. 6, line 2), (90/008,178, Office

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Action of 12/21/2007, Page 14, Paragraph following figure – Page 15, Line 6).

None of these references teach a renumbering operation as described by the applicants. The claims were recast to clarify that the renumbering recitation is patentably distinct from the instruction substitution operation of the Java Virtual Machine Specification, the instruction re-ordering of Tannenbaum, and the operand substitution of Gosling. Therefore, it is clear from the prosecution history that the amendment to the renumbering operation was not intended to change the meaning of the claim but rather to clarify the intended meaning. In the original meaning of the claim, the target instruction set for the renumbering operation would have been the instruction set of the interpreter that was going to do the interpretation, i.e., in the case of the *Integrated Circuit Card Claims*, the interpreter on the integrated circuit card, and in the case of the *Microcontroller Claims,* the interpreter on the microcontroller. Otherwise, the renumbering operation would not have produced a program in a format suitable for interpretation as recited in the claims prior to the amendment.

Thus, the prosecution history shows that the proper correction would be to change "the integrated circuit card" to "the microcontroller" in the claims affected by the mistake.

For the foregoing reasons, Applicants submit that the prosecution history supports the correction proposed for the certificate of correction because the claim prior to the Amendment reads on the structure proposed by the correction and the changes made were intended to merely clarify that structure.

Conclusion with Respect to the Nature of the Mistake

The arguments provided herein above demonstrate that the mistake is "of minor character" because correction thereof is a mere clarification of a claim element that does not broaden the claim, but rather narrows it. Even if

deemed a broadening correction, the correction should be allowed under the rule set forth in *Arthrocare* because it is evident from the specification, drawings and prosecution history how the mistake should be corrected.

The Nature of the Correction Does Not Constitute New Matter and Is Such as to Not Require Reexamination

A second condition for issuance of a Certificate of Correction is that "the correction of which does not involve such changes in the patent as would constitute new matter or would require reexamination."

"Fig. 21 shows an integrated circuit card, or smart card, which includes a microcontroller 201 that is mounted on the plastic card 212." Figure 21 is reproduced here:
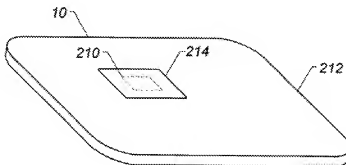

FIGURE 21

"A microcontroller includes a central processing unit, memory and other functional elements..." Col. 2, Lines 2 – 3. Thus, when in Figure 1, the interpreter is illustrated as being located on the integrated circuit card, when it is loaded onto a memory of the integrated circuit card, it may be, at least in the embodiment illustrated in Figure 21, loaded onto the memory of the microcontroller of the integrated circuit card. That alternative view is captured by the *Microcontroller Claims.* Accordingly, the proposed correction does not add new matter.

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As has been described in detail herein above, the proposed correction defines an instruction set that is a subset of any reasonable interpretation of the claim without the correction. Thus, if the claim after applying the proposed correction were non-patentable over the prior art, the claim before applying the correction would have been non-patentable for the same reason. Therefore, the proposed correction cannot be non-patentable over any prior art that would not have been found applicable to the non-corrected claims. Accordingly, no reexamination is necessary for the claims after applying the correction.

Alternative Correction Proposed by Examiner Eric Keasel in Telephone Conversation

On September 20, 2010, the undersigned attorney discussed the rejection of the Request for Certificate of Correction with Examiner Eric Keasel, who had indicated to the Decisions & Certificate of Corrections Branch that the requested changes are not of a clerical nature, typographical error or a mistake of minor character. *SPE Response for Certificate of Correction*. In that telephone conversation, Examiner Keasel proposed an alternative correction, namely changing the *the* in the phrase "the integrated circuit card" to "an" as in "renumbering byte codes in the compiled form to equivalent byte codes in an instruction set supported by an interpreter on *an* integrated circuit card." (Eric Keasel, Teleconference w/ Pehr Jansson, September 20, 2010).

That correction would not be evident from the specification, drawings and prosecution history. "An interpreter on *an* integrated circuit card" opens the claim to many target instruction sets because, with the integrated circuit card not specified, the interpreter could be on any integrated circuit card. I.e., there would essentially be no limit on the target instruction set. However, using a reference interpreter for defining the target instruction set

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that is different from the interpreter that will do the interpretation is not described by the specification and drawings and is not evidenced by the prosecution history. Furthermore, if the reference interpreter defines an instruction set that is different from "the interpreter on the microcontroller," the derived application program would not necessarily be interpretable by the interpreter used by the processor to interpret the derivative program. For these reasons, Examiner Keasel's suggested way of correcting the mistake is not evident from the specification, drawings, and prosecution history, rather it is contrary thereto.

In Summary

Please consider the conditions that must be met for the issuance of a Certificate of Correction one-by-one:

| (A) mistake must be of a clerical or typographical nature, or of minor character, the correction of which does not involve such changes in the patent as would constitute new matter or would require reexamination; | Applicant made an error that is either to be considered of minor character or is a clerical or typographical error for which appropriate correction (as proposed) is evident from the specification and prosecution history. The amendment refers to "the integrated circuit card," which is a reference back to a prior use of "integrated circuit card" in the claims. The term "integrated circuit card" does not appear in the microcontroller claims, so there is no antecedent basis for use of "the integrated circuit card." The error occurred when the prosecuting attorney crafted the amendment for claim 1, which is directed to an integrated circuit card, and then decided to use this amendment globally, neglecting the fact that some independent claims with the same limitation are directed to a microcontroller. The correction |

	narrows the definition for the target instruction set of the renumbering operation. How to correct the error is clearly evident, including to one of ordinary skill in the art, as demonstrated by the attached Certificate of Correction.
(B) which was not the fault of the Patent and Trademark Office;	The mistake was made by Applicant in the February 21, 2008 Amendments to the claims and related Remarks. Thus, the mistake is not the fault of the Patent and Trademark Office.
(C) such mistake occurred in good faith; and	As noted above, the specification and prosecution history make clear that Applicant made a mistake when amending the microcontroller claims. The undersigned of this Petition hereby swears that he is the same attorney that made the amendment during the '317 reexamination and that the mistake was in good faith.
(D) payment of the required fee.	The fee set forth in MPEP § 1.20(a) was submitted with the filing of the Request for Certificate of Correction.

Thus, all the requirements of for accepting a Certificate of Correction to correct Applicant's mistake under 35 U.S.C §355 apply here. Accordingly, Patentee petitions the Commissioner to reverse the decision made on the Request for Certificate of Correction and to accept the attached Certificate of Correction.

If any fees are required in conjunction with the filing of this petition, the Commissioner is hereby authorized to charge such fees from deposit account 502114.

Respectfully submitted,

Date: October 6, 2010

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